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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,810

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Johannes Georg Schaede

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EXAMINER

GRABOWSKI, KYLE ROBERT

ART UNIT

PAPER NUMBER

3709

MAIL DATE

DELIVERY MODE

08/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,810

Applicant(s)

SCHAEDE, JOHANNES GEORG

Examiner

Kyle R. Grabowski

Art Unit

3709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/24/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/24/05, 11/15/06</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 13-15, 17-19, 21-22, and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Mayer et al. (US 6712397 B1). Mayer et al. discloses: a data carrier such as bank notes, ID card, or the like, (Abstract) with a security element 2 (Fig. 1) in the form of an embossment; the checking of the security element “can be carried out by purely tactile means “ (Col. 1, Lns 24-25); a succession of marks long in proportion to their breadth (lines) - comprising a variety of shapes having an asymmetrical relief profile (Fig. 2, 4, & 6); lines in the succession of asymmetrical relief profiles are arranged “contrary to one another” (Col. 4, Ln 34); the embossing is “preferably created using the intaglio imprinting method” (Col. 2, Lns 36-37) utilizing “printing plates [that] are not filled with ink during the printing process but are simply used to deform, i.e. emboss, the document material” (Col. 2, Lns 44-46).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 13, 16, 19 and 20, are rejected under 35 U.S.C. 102(e) as being anticipated by Yokote et al (US 2004/0195823 A1). Yokote et al. discloses: an authenticity determinable printed matter comprising a succession of ink lines (Fig. 1); “since the image line itself has an ink layer thickness, tactile sensible printed matter can be obtained” (Para 0225, Lns 10-12); an asymmetrical relief profile (Fig. 2) comprising a succession of shapes; lines are shown in succession with different orientations on two neighboring tactile zones with different directional palpability (Fig. 1).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 23-26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokote et al. (US 2004/0195823 A1). Yokote et al. discloses all of the claimed subject matter except: first and second tactile zones placed next to each other respectively on a recto side and a verso side of the object, or a succession of tactile zones alternately disposed on the recto and verso sides of the object.

8. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to duplicate the inventive security element taught in Yokote et al. The tactile zones themselves are completely disclosed in Yokote et al. and a mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). The applicants only stated reason or advantage for the "alternate effect" is that both the thumb and index finger can be used to detect the tactile effect: the ability to feel a separate zone with a second finger is an expected result and therefore the duplication in these claims have no patentable significance.

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9. Furthermore, the verso and recto side of the object are interchangeable in respect to these claims; there is reason or advantage stated for preference for applying the security element to either side. Again, the applicants only stated reason or advantage for the "alternate effect" is that both the thumb and index finger can be used to detect the tactile effect, which lends the duplication no patentable significance.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Grabowski whose telephone number is (571) 270-3518. The examiner can normally be reached Monday through Thursday and every other Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrence R. Till can be reached at (571) 272-1280.

KG

KG



Terrence R. Till
Supervisory Patent Examiner